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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,226	12/17/2001	Matthias Stefan Bierbrauer	DE920000116US1	6251

7590 10/28/2004

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EXAMINER
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HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 10/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/015,226

Applicant(s)

BIERBRAUER ET AL.

Examiner

Calvin L Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11-19-02
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Status of Claims***

1. Claims 1-32 have been examined.

***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The Applicant's claimed invention does not fall within the technological arts because no form of technology is disclosed or claimed. Claim 1 recites transferring content to a repository and "replacing the content by a URL link placeholder". However, each of these processes can be performed by an off-line method such as placing content in a box or file (i.e. repository) then handing the depositor a paper receipt with a URL link written on it. Hence, the claimed invention does not promote the progress of science and the useful arts.

Claims 2-13 are also rejected as they depend from claim 1.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 20-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 is directed to a “computer program product stored on a computer readable medium”. However, the body of the claim recites structure (“means for”), therefore, it’s not clear to one of ordinary skill what is the scope of the Applicant’s claim.

Claims 21-32 are also rejected as they depend from claim 20.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3, 5-9, 11, 13-17, 20-22, 24-28, 30 and 32 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Beattie et al., U.S. Patent No. 5,659,742.

As per claims 1-3, 5-9, 11, 13-17, 20-22, 24-28, 30 and 32, Beattie et al. teach a system for off-loading content comprising:

- detaching content from a document, wherein the content is the whole document or at least part of the document (figure 1)
- transferring the content to a repository (figure 1)
- replacing the content by a URL link placeholder, wherein the link contains additional information identifying the off-loaded content such as information about the user who of-loaded the content and/or the time/day of off loading and/or an original document/content designation (figures 4A and 5; column 8, lines 60-64; column 11, lines 60-65)
- viewing the detached content at the client via the URL link using a web browser (or HTTP client tool) (figures 4A-C; column 11, lines 60-65)
- a web dispatcher component as a stripped down web server that provides access to off-loaded content (figure 1; column 10, lines 31-39; column/line 20/25-21/25; column 30, lines 48-67)

- access requests to be processed by the web dispatcher are sent as HTTP requests with a defined parameter set (figures 1 and 4; column 11, lines 60-65; column 12, lines 15-53)
- assigning a unique identifier for off-loaded content (figure 5)
- storing document content type with the content when it is off-loaded (figures 5 and 5B; column/line 12/54-13/29; column/line 16/59-17/10; column 17/50-2)
- performing a search over a repository containing off-loaded content, returning a hitlist document, and for every hitlist document displaying a button to retrieve the content associated with a hit and/or a URL link to view the content associated with the hit (figures 4A-C; column 12, lines 15-45)

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4, 10, 12, 18, 19, 23, 29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beattie et al., U.S. Patent No. 5,659,742.

As per claims 4 and 23 Beattie et al. teach placing detached content on the internet in the form of a URL (figure 4A; column 11, lines 60-65). The Beattie et al. system is not tied to a particular type of URL. Beattie et al. only require that the document is accessible via the internet (column 8, lines 60-64). To one of ordinary skill, there are many types of URLs (http, javascript, Notes, ftp). Similarly, Lotus Notes and its various functionalities are old and well-known, hence it would have been obvious to one of ordinary skill to use Notes URL to make a document accessible over a computer network such as the Internet.

As per claims 10, 18, and 29, a URL link comprises a server and a path. The path represents a file location. Hence, it would have been obvious to one of ordinary skill to use a unique identifier such as the content identification number of Beattie et al. (figure 5, item 401) to name the file, where the content resides on the server.

As per claims 12, 19 and 31, Beattie et al. teach making content available over the internet (column 8, lines 60-64; column 11, lines 60-65). Internet e-mail and websites sending customers content via e-mail are old and well-known. Hence, it would have been obvious to one of ordinary skill use MIME in order to more efficiently transfer data to users via internet mail.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Wu teaches a information retrieval system
- Wesinger et al. teach an automated on-line information system

11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
c/o Technology Center 2100  
Washington, D.C. 20231

or faxed to:

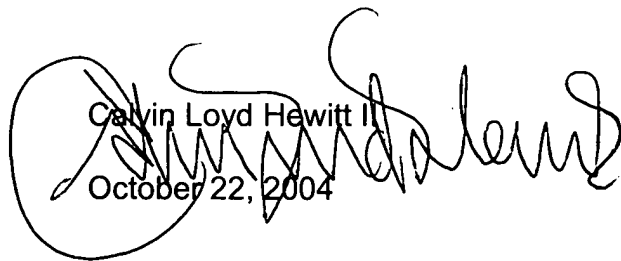
(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:

(703) 746-5532 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5,  
2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application  
should be directed to the Group receptionist whose telephone number is (703)  
308-1113.

  
Calvin Loyd Hewitt II  
October 22, 2004